



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,402	07/05/2000	Jonathan Stephen Levkoff	MSGNT-001	4157

26137 7590 08/09/2005

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10036

EXAMINER

LE, HIEU C

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,402

Applicant(s)

LEVKOFF ET AL.

Examiner

Hieu c. Le

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RD

DETAILED ACTION

1. Applicant's election without traverse of group I (claims 12,15-16) in the reply filed 6/13/05 on is acknowledged

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12,15-16 recite the limitation "the recipient alias" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12, is rejected under 35 U.S.C. 103(a) unpatentable as being Edelstein et al. (US Patent 5,764, 906) in view of Kane et al (US Patent 5,487, 100) and further in view of Okada (US Patent 6,101,548).

As to claim 12, [As best understood by the Examiner] Edelstein discloses a method for transmitting a message to a recipient, the recipient is associated with an alias identifier, the alias identifier is associated with at least one permission criteria, the alias identifier is further associated with at least one communication device, comprising:
received a message (col. 7, lines 2-3);

receiving a recipient identifier for the message, the recipient alias associated with at least one communication device (col. 7, lines 5-10);

verifying that the recipient identifier is available to the system (col. 7; lines 7-10).

verifying that the sender has permission to send a message to the identifier by referring to the permission associated with the identifier [the delivery services to clients employs a number of electronic or non electronic devices such as fax; telephone and postal service, the user may request to deliver the message by fax or in printed form by mail (col. 7, lines 4-11) (i.e. permission criteria associated with the alias)].

retrieving a maximum message length for a communication device associated with the identifier (col. 6, lines 40-50).

Edelstein does not disclose,

transmitting the message to at least one communication device.

determining the message length of the received message;

comparing the message length of the received message to the maximum message length;

Kane discloses an e-mail message delivery system that delivers e-mail from originating devices to destination devices using alias (col. 1, lines 65-col. 2, line 7). The messages are accumulated for each subscriber in a message database (compiled) (col. 5, lines 24-34). The system determines a maximum message length to be communicated to limit the size of the message and the bandwidth of the communication channel (col. 7, lines 62-col. 8, line 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kane's teachings to modify the method of Edelstein by transmitting the message to at least one communication device, determining the message length of the received

Art Unit: 2142

message; comparing the message length of the received message to the maximum message length; and modifying the transmission of the message when the message length of the received message exceeds the maximum message length in order to limit and conserve the bandwidth of the communication channel and enable subscribers to better manage their the costs of receiving messages.

Neither Edelstein nor Kane discloses modifying the transmission of the message when the message length of the received message exceeds the maximum message length by sending the message in more the one transmission.

Okada discloses a terminal device such as facsimile device with a function of transmitting original document image data to a destination by electronic mail. Before image data transmission to a destination by electronic mail data, main controller of the facsimile device converts the image data on one page of original document to electronic mail data and determines how much volume the image data has. The image data on one page of original document is transmitted to a destination by a single electronic mail when the calculation result does not exceed a prescribed volume. On the other hand, the original image on one page of original document is divided up into smaller species of data and transmitted to destination by a plurality of electronic mails respectively when the calculation result exceeds a prescribed volume.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Okada's teachings to modify the combined method of Edelstein and Kane by modifying the transmission of the message when the message length of the received message exceeds the maximum message length by sending the message in more the one transmission

Art Unit: 2142

in order to manage a large volume of the message data that exceeds a prescribed volume and facilitate handling of the message on the receiving side.

Claims 15,16 would be allowable if overcome the 112,2nd paragraph rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (571) 272-3897. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Caldwell Andrew, can be reached on (571) 272-3868. The fax phone number for this Group is (571)-273-3897.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 273-8300.

Hieu Le

A handwritten signature in black ink, appearing to read "Andrew Caldwell", with a stylized, looping flourish at the end.

**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**